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In re Application of :
Bura et al. :
Application No.: 10/018,621 : DECISION ON
PCT No.: PCT/GB00/02224 :
Int. Filing Date: 08 June 2000 : PETITION
Priority Date: 18 June 1999 :
Attorney's Docket No.: 508-042.008 : UNDER 37 CFR 1.47(a)
For: BRIDGE JOINT :

This is a decision in response to the declaration and petition filed under 37 CFR 1.47(a) on 08 August 2002 to accept the application without the signature of co-inventor Michael J. Bura. The required \$130 petition fee has been paid.

BACKGROUND

On 08 June 2000, applicants filed international application PCT/GB00/02224 that claimed priority of an earlier British application filed 18 June 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 28 December 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 15 January 2001 prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 18 December 2001.

On 17 December 2001, applicants filed a letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a copy of the international application and the basic national fee of \$445 as required by 35 U.S.C. 371(c). These papers were assigned application number 10/018,621.

On 05 February 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING

REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)” (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration. The notification set a two-month time period in which to respond.

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), on 08 August 2002, applicants filed the following papers:

- 1) a Response to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) including a Petition under 37 CFR 1.47(a);
- 2) the required petition fee;
- 3) a declaration signed by inventor Seamus M. Devlin;
- 4) the last known address of Michael J. Bura;
- 5) a statement from Nigel Brooks;
- 6) a petition and fee for a four month extension of time; and,
- 7) the \$65 surcharge for filing the oath/declaration after 30 months from the earliest priority date.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing inventor. The petition is missing item (2) above.

With respect to item (1), applicant has included the \$130 petition fee. With respect to item (3), applicant has provided inventor Bura’s last known address. With respect to item (4), applicant has provided a declaration signed by inventor Seamus.

MPEP §409.03(b) states, in part:

“Where inability to find or reach a nonsigning inventor “after diligent effort” is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions."

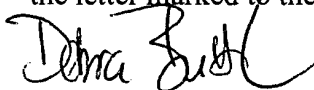
With respect to item (2), applicants have not provided any proof that the missing joint inventors refuse to sign or cannot be reached after diligent effort. Although Mr. Brooks has provided a statement, Mr. Brooks did not make any effort to find inventor Bura. Therefore, Mr. Brooks does not have first hand knowledge of the facts. Further, applicants have not furnished any documentation to indicate that inventor Bura was ever provided with a copy of the entire application in an effort to get his signature.

CONCLUSION

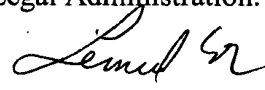
For the reasons above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Applicant is advised that, effective May 1, 2003, the Office has changed its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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